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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,430	10/04/2005	David Jeal	P08620US00/BAS	8714
881 7590 01/21/2009 STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			EXAMINER HENNING, MATTHEW T	
			ART UNIT 2431	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,430

Applicant(s)

JEAL ET AL.

Examiner

MATTHEW T. HENNING

Art Unit

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-53 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

This action is in response to the communication filed on 4/15/2005.

DETAILED ACTION

Claims 1-53 have been examined.

Title

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Information Disclosure Statement

The information disclosure statement(s) (IDS) submitted on 4/15/2005 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

Drawings

The drawings filed on 4/15/2005 are acceptable for examination proceedings.

Specification

The abstract of the disclosure is objected to because:

The abstract contains trademarks which have not been identified properly.

Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities:

The disclosure lacks section headings.

The use of the trademark WINDOWS has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

The examiner encourages the applicants to carefully check the specification to ensure that no other trademarks have been used without proper capitalization and accompaniment by the generic terminology.

Claim Objections

Claims 2, 5, 14, 15 and 24 are objected to because of the following informalities:

Claims 2, and 5 misspells the word “analyzing”.

Claim 14 recites “by means of use of a” which is not grammatically correct.

Claim 15 recites “the data processing functions” which lacks antecedent basis in the claim.

Claim 24 recites “the alphanumeric data entry means”, which lacks antecedent basis in the claim. The examiner will assume for the purpose of searching prior art that this claim was meant to depend from claim 23. Appropriate correction is required.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

1 (b) the invention was patented or described in a printed publication in this or a foreign
2 country or in public use or on sale in this country, more than one year prior to the date of
3 application for patent in the United States.
4

5 Claims 1-3, 5, 14-17, 19-23, 25, 34-38, and 41-43 are rejected under 35 U.S.C. 102(b) as
6 being anticipated by Ohashi et al. (US Patent Number 5,761,309) hereinafter referred to as
7 Ohashi.

8 Regarding claims 1, 21, and 42, Ohashi disclosed a device (card reader 11) for
9 connection to a data processing apparatus (client terminal 12), the device (card reader 11)
10 including authentication storage means (smart card 10) operatively coupled thereto for storing
11 predetermined authentication information respective to a user (Ohashi Col. 12 Lines 1-29), the
12 authentication storage means (smart card 10) being registered with a telecommunications system
13 (authentication center) which includes authenticating means (AuC data) and for which the user
14 has a telecommunications terminal (client terminal 12), the device (card reader 11), when
15 operatively coupled to the authentication storage means (smart card 10), being responsive to an
16 input message for deriving a response dependent on the input message and on the authentication
17 information for enabling the authenticating means (AuC data) to carry out the authentication
18 process via a communication link (network 13) with the authenticating means (AuC data) in the
19 said telecommunications system (authentication center) whereby to authenticate a subsequent
20 transaction by the user with the data processing apparatus (client terminal 12) (Ohashi Col. 12
21 Lines 1-29), and which involves use of the data carded by the authentication storage means
22 (smart card 10) (Ohashi Col. 12 Lines 1-29), the predetermined authentication information stored
23 by the authentication storage means (smart card 10) corresponding to information which is used
24 to authenticate the user registered with the telecommunications system (authentication center) in

relation to use of that users telecommunications terminal in the telecommunications system (authentication center) (Ohashi Col. 12 Lines 1-29).

Regarding claims 2 and 22, Ohashi disclosed security data entry means for obtaining security data independently of the data processing apparatus, and means for analyzing the entered security data for determining whether to allow access to the predetermined information (Ohashi Col. 12 Lines 1-29).

Regarding claims 3, and 23, Ohashi disclosed wherein the data entry means comprises alphanumeric data entry means (Ohashi Col. 12 Lines 1-29).

Regarding claims 5, 25, and 43, Ohashi disclosed that the security data comprises a Personal Identification Number (PIN) and the analyzing means compares the PIN obtained by the security data entry means with a PIN stored on the authentication storage means and only allows access to the predetermined information when the respective PINs match (Ohashi Col. 12 Lines 1-29).

Regarding claims 14 and 34, Ohashi disclosed that each user is authenticated in the telecommunications system by means of use of a subscriber identity module, and in which the authentication storage means respective to that user corresponds to or simulates the subscriber identity module (Smartcard) for that user (Ohashi Col. 12 Lines 1-29).

Regarding claims 15, and 35, Ohashi disclosed that the transaction is a transaction involving use of the data processing functions of the data processing apparatus (Ohashi Col. 12 Lines 30-36).

Regarding claims 16, and 36, Ohashi disclosed that the authentication storage means is specific to that device (Ohashi Col. 11 Lines 65-67).

Regarding claims 17, and 38, Ohashi disclosed that the authentication process involves the sending of a message and the generation of a response dependent on the message and the predetermined information (Ohashi Col. 12 Line 55 – Col. 13 Line 10).

Regarding claims 19 and 20, see Ohashi Fig. 1.

Regarding claim 37, Ohashi disclosed that the authentication storage means is associated with the data processing apparatus by being associated with data or software for use by that data processing apparatus (Ohashi Col. 12 Lines 1-29).

Regarding claim 41, Ohashi disclosed that the data processing apparatus is a personal computer (Ohashi Col. 5 Paragraph 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 39-40, 46-51, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohashi.

Regarding claims 18, and 39-40, while Ohashi disclosed providing a network service, Ohashi fails to disclose the system levying a charge for the service transaction. However, it was well known in the art of service providing to levy charges for providing the service. As such, it would have been obvious to the ordinary person skilled in the art at the time of invention to have had the system levy a charge for the service. This would have been obvious because the ordinary

1 person skilled in the art would have been motivated to provide the service provider with
2 compensation for the service.

3 Regarding claims 46, 49, and 53, while Ohashi disclosed the smart card communicating
4 with a smart card reader, Ohashi failed to disclose the communication being wireless. However,
5 it was well known at the time of invention for smart cards to communicate wirelessly. As such,
6 it would have been obvious to the ordinary person skilled in the art at the time of invention to
7 have provided the communications wirelessly. This would have been obvious because the
8 ordinary person skilled in the art would have been motivated to increase the ease of use for the
9 user.

10 Regarding claim 47, 48, 50 and 51, while Ohashi disclosed the smart card operable in a
11 general purpose personal computer and authenticating the computer for use in the system, Ohashi
12 failed to disclose that the computer could be a mobile computer. However, mobile computers,
13 such as laptops, pda's, and telephones were well known in the art at the time of invention. As
14 such, the ordinary person skilled in the art at the time of invention would have found it obvious
15 to modify Ohashi to include laptops, pda's telephones, and other such known mobile computers.
16 This would have been obvious because the ordinary person skilled in the art would have been
17 motivated to provide the user with more flexibility and ease of access.

18
19
20

Claims 4, 6-13, 24, 26-33, 44-45, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohashi as applied to claims 1, 21, and 42 above, and further in view of Caputo et al. (US Patent Number 5,778,071) hereinafter referred to as Caputo.

Regarding claims 4, 6, 24 and 26, while Ohashi disclosed a smart card reader, and entry of PIN numbers, Ohashi failed to disclose the smart card reader having a keypad or a display.

Caputo teaches, in Fig. 1E and Col. 7 Lines 37-61, a smart card reader which has a keypad and a display for facilitating the entry of PIN numbers.

It would have been obvious to the ordinary person skilled in the art at the time of invention to have employed the teachings of Caputo in the smart card system of Ohashi by utilizing the smart card reader of Caputo. This would have been obvious because the ordinary person skilled in the art at the time of invention would have been motivated to provide a specific means for the entry of PIN numbers, as generically suggested by Ohashi.

Regarding claims 7 and 27, Ohashi and Caputo taught a data processing module for controlling the communication with the data processing apparatus (See Caputo Fig. 2 Element 172).

Regarding claims 8 and 28, Ohashi and Caputo taught that the data processing module of the device is configured for communicating with a corresponding data processing module of the data processing apparatus (Caputo Fig. 5A).

Regarding claims 9 and 29, Ohashi and Caputo taught that communication between the authentication storage means and the data processing apparatus is performed via the respective data processing modules (Caputo Fig. 2).

Regarding claims 10, 30 and 44, Ohashi and Caputo taught that the data processing module of the device includes means for decrypting encrypted data received from the data processing module of the data processing apparatus (Ohashi Col. 12 Lines 30-36 and Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

Regarding claims 11, 31, and 45, Ohashi and Caputo taught the data processing module of the device includes means for encrypting data transmitted to the data processing module of the data processing apparatus (Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

Regarding claims 12, 32, and 52, Ohashi and Caputo taught that the respective data processing modules comprise a key for allowing encryption and/or decryption of data (Caputo Fig. 6).

Regarding claims 13, and 33, Ohashi and Caputo taught that the key comprises a shared secret key for each of the respective data processing modules (Caputo Fig. 6 and Col. 10 Line 51 - Col. 11 Line 59).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-53 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/531,429, and all pending claims of copending Application No. 10/574,808. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the claims of the copending applications are merely well known variations of the SIM authentication protocol and the use of SIM cards. As such, the ordinary person skilled in the art at the time of invention would have found the differences between the copending applications obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Claims 1-53 have been rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW T. HENNING whose telephone number is (571)272-3790. The examiner can normally be reached on M-F 8-4.

1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's
2 supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the
3 organization where this application or proceeding is assigned is 571-273-8300.

4 Information regarding the status of an application may be obtained from the Patent
5 Application Information Retrieval (PAIR) system. Status information for published applications
6 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
7 applications is available through Private PAIR only. For more information about the PAIR
8 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR
9 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would
10 like assistance from a USPTO Customer Service Representative or access to the automated
11 information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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13
14 /Matthew T Henning/
15 Examiner, Art Unit 2431
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